

REMARKS/ARGUMENTS

Claims 1-6 are pending. Solely in an effort to advance prosecution, claims 1 and 6 have been amended, and claim 7 has been canceled. In the Final Office Action dated June 15, 2007, all pending claims were rejected under 35 U.S.C. § 103 as allegedly obvious(i) that all claims are obvious over U.S. Patent No. 6,818,146 to Eaton et al. (Eaton) in light of PCT Pub. No. WO 02/055630 (PCT '630) and (ii) that all claims are obvious over PCT Pub. No. WO 02/055759 in light of PCT '630.

In making both obviousness rejections, the Office Action requested evidence showing a "beneficial and or synergistic" result of the claimed subject matter. (Final Office Action at 3 & 4.) Applicants respectfully submit that the as-claimed subject matter is patentable over the cited references, at least for the reason that the as-claimed subject matter has beneficial, unpredictable properties beyond those disclosed in the cited references. These beneficial, unpredictable properties include an increased longevity in low conductivity, as exemplified in the experimental data reported in the specification..

A portion of the specification (see p. 5, ll. 14-18) explains:

The novel ready-to-use aqueous coolant compositions have an initial electrical conductivity of not more than 50, in particular 25, preferably 10, especially 5 $\mu\text{S}/\text{cm}$ or less. The conductivity is kept at this low level during continuous operation of the fuel cell drive over several weeks or months, in particular if a cooling system having an integrated ion exchanger is used in the fuel cell drive.

As noted in the quoted passage, the conductivity of the compositions of present disclosure remain relatively constant during operation of the fuel cell over time. This objective indicia of nonobviousness shows, at a minimum, an unexpected result over

the cited prior art. Evidence of this beneficial, unpredictable property is shown in table 1, which shows that there is no appreciable increase in electrical conductivity over a 28-day experiment. The comparative example, on the other hand, shows a steadily increasing electrical conductivity. This objective evidence disproving obviousness must be considered by the Patent Office. *See, e.g., In re Sullivan*, ___ F.3d ___, Dkt. No. 2006-1507 (Fed. Cir. Aug. 29, 2007) (holding that the Patent Office reversible erred in failing to “meaningfully consider” competent evidence rebutting a conclusion of obviousness).

Even assuming, *arguendo*, that the Patent Office has set forth a proper *prima facie* case of obviousness by merely finding individualized disclosures of particular portions of the claimed subject matter and piecing those disclosures together, there is nothing that even hints that an ordinarily skilled artisan would expect the beneficial properties of the pending subject matter. Indeed, as described in the specification, the electrical conductivity of the disclosed compositions remains substantially constant throughout 28 days of use.

In the Advisory Action dated September 20, 2007, the Patent Office stated: “The claims remain rejected for [reasons] disclosed in the final office action. Specifically, applicant has [not] shown in Table 1 unexpected data commensurate in scope with the claimed invention as argued.” In response to the Office’s comments, Applicants have now amended claims 1 and 6 to align the claims with the disclosure (e.g., p. 5, ll. 14-18). Applicants also emphasize that it is not solely the data presented in Table 1; rather, it is believed that the beneficial property exists in inventive compositions and methods beyond that disclosure.

Applicants submit that there is no reason to believe that the scope of the pending claims would have been obvious over the selective portions of the cited prior art. Applicants further submit that there is no persuasive evidence to believe that the pieced-together portions of the prior art would exhibit a relatively constant conductivity over time as described in the specification. Applicants therefore submit that the presently amended claims are in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

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